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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,336	06/13/2002	Tatsuya Inokuchi		2868
530	7590	10/12/2006		
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			EXAMINER	
			KIM, JUNG W	
			ART UNIT	PAPER NUMBER
			2132	

DATE MAILED: 10/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/088,336	INOKUCHI ET AL.	
	Examiner	Art Unit	
	Jung Kim	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 September 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-33 and 36-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 8-15, 26-33 and 36-58 is/are allowed.
- 6) Claim(s) 1-7, 16, 17 and 19-25 is/are rejected.
- 7) Claim(s) 18 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



KAMBIZ ZAND
 PRIMARY EXAMINER

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date 27/10/06
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

1. This Office action is in response to the amendment filed on April 11, 2006.
2. Claims 1-33 and 36-59 are pending.
3. Claim 59 is new.

Response to Amendment

4. The provisional double patenting rejection is withdrawn as the terminal disclaimer filed on 9/11/06 overcomes the provisional double patenting rejection.

Response to Arguments

5. The 112/2nd paragraph rejections to claims 1-7 are withdrawn, as applicant's arguments, on pgs. 20-23 in the Remarks, are persuasive.
6. Applicant's arguments against the prior art rejections to claims 1-25 are persuasive. (see in particular, pgs. 24-25) These rejections have been withdrawn. However, upon further consideration, a new ground(s) of rejection of claims 1-7 and 16, 17 and 19-25 is made in view of Wiser et al. USPN 6,385,596 (hereinafter Wiser) and Kupka.

Information Disclosure Statement

7. The IDS submitted on 7/10/06 has been considered. An initialed copy of the IDS is enclosed.

Claim Rejections - 35 USC § 103

8. Claims 1-6, 16, 17, 19-24 and 59 are rejected under 35 USC 103(a) as being unpatentable over Wiser et al. USPN 6,385,596 (hereinafter Wiser) in view of Kupka et al. PCT application publication No. WO 00/29928 (hereinafter Kupka).
9. As per claim 1, Wiser discloses a method for recording data to a recording medium, comprising steps of:
 - a. detecting, when a recorder is going to record data to the recording medium, whether a terminal unit with a memory having media identification information recorded therein is connected; (col. 4:51-67)
 - b. when it is detected that the terminal unit is connected to the recorder, exchanging an encryption key between the recorder and the terminal unit; (col. 8:57-9:36)
 - c. encrypting the media identification information read from the memory of the terminal unit with the exchanged encryption key and sending the media identification information from the terminal unit to the recorder; (19:15-19)
 - d. encrypting the data to be recorded to the recording medium with the user identification sent from the terminal unit and recording the encrypted data to the recording medium. (6:38-40; 19:25-43)
10. Wiser does not disclose the media identification information including user identification information. Kupka discloses a system for keying protected electronic data

using a compound key, wherein the compound key includes a user identifier; and wherein the compound key is used to encrypt the requested electronic data at the server prior to sending the electronic data to the user (pg. 27, line 23-p. 30, line 14). It would be obvious to one of ordinary skill in the art at the time the invention was made for the media identification information to include user identification, wherein the user identification is utilized as part of the encryption key to secure the requested electronic data. One would be motivated to do so to provide additional security by associating the downloaded electronic data to the user, as taught by Kupka, pg. 27, lines 22-26. The aforementioned cover the limitations of claim 1.

11. As per claims 2-4, the rejection of claim 1 under 35 USC 103(a) as being unpatentable over Wiser in view of Kupka is incorporated herein. (supra) In addition, Wiser discloses the recorder authenticating the terminal unit when it is detected that the terminal unit is connected to the recorder. (col. 18:66-19:9) Furthermore with regard to the limitations of claims 2-4, these limitations are notoriously well known enhancements in the art. Examiner takes Official Notice of these teachings. It would be obvious to one of ordinary skill in the art at the time the invention was made to cease recording data when the recorder is not successfully authenticated to the terminal unit, because this step ensures that only authenticated users have access to the digital data. (Virtually every access program authenticating a user has this feature) It would be obvious to one of ordinary skill in the art at the time the invention was made to display an error message when the recorder has not successfully authenticated the terminal unit,

because it facilitates corrective action to be taken by the user to be successfully authenticated. (e.g. an error pop up message in the user's window) It would be obvious to one of ordinary skill in the art at the time the invention was made to display an indication that the terminal unit is not connected when it is detected that the terminal unit is not connected because it facilitates the correct action to be taken by the user for proper operation. (e.g. an error pop up message in the user's window) The aforementioned cover the limitations of claims 2-4.

12. As per claims 5 and 6, the rejection of claim 1 under 35 USC 103(a) as being unpatentable over Wiser in view of Kupka is incorporated herein. In addition, the user identification information is stored in the memory of the terminal unit is set by the user and includes a user name; (Kupka, pg. 28, lines 9-10) and the user identification information includes information unique to the terminal unit, having been set at the time of shipment from the factory. (compound key includes unique identifier)

13. As per claim 16, the rejection of claim 1 under 35 USC 103(a) as being unpatentable over Wiser in view of Kupka is incorporated herein. In addition, Wiser and Kupka discloses a method of playing back a recording medium, comprising the steps of: when a player is going to play back a recording medium containing user identification information, intended to identify a user, and data having been encrypted with the user identification information and stored in the recording medium therewith, judging whether user identification information read from an information holder provided in the player to

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hold user identification information sent from a terminal unit is coincident with user identification information read from the recording medium; and decrypting encrypted data read from the recording medium when the user identification information read from the information holder provided in the player is coincident with the user identification information read from the recording medium. (Wiser, col. 19:50-60; Kupka, pg. 27, line 23-p. 30, line 14) It would be obvious to one of ordinary skill in the art at the time the invention was made for the media identification information to include user identification, wherein the user identification is utilized as part of the encryption key to secure the requested electronic data. One would be motivated to do so to provide additional security by associating the downloaded electronic data to the user, as taught by Kupka, pg. 27, lines 22-26. The aforementioned cover the limitations of claim 16.

14. As per claims 17 and 19-22, the rejection of claim 16 under 35 USC 103(a) as being unpatentable over Wiser in view of Kupka is incorporated herein. In addition, Wiser discloses the recorder authenticating the terminal unit when it is detected that the terminal unit is connected to the recorder. (col. 18:66-19:9) Furthermore with regard to the limitations of claims 17 and 19-22, these limitations are notoriously well known enhancements in the art. Examiner takes Official Notice of these teachings. It would be obvious to one of ordinary skill in the art at the time the invention was made to cease recording data when the recorder is not successfully authenticated to the terminal unit and/or when the user identification information read from the memory of the terminal unit is not coincident with the user identification information read from the recording

medium, because this step ensures that only authenticated users have access to the digital data. (Virtually every access program authenticating a user has this feature) It would be obvious to one of ordinary skill in the art at the time the invention was made to display an error message when the recorder has not successfully authenticated the terminal unit, because it facilitates corrective action to be taken by the user to be successfully authenticated. (e.g. an error pop up message in the user's window) It would be obvious to one of ordinary skill in the art at the time the invention was made to display an indication that the terminal unit is not connected when it is detected that the terminal unit is not connected because it facilitates the correct action to be taken by the user for proper operation. (e.g. an error pop up message in the user's window) The aforementioned cover the limitations of claims 17 and 19-22.

15. As per claims 23 and 24, the rejection of claim 17 under 35 USC 103(a) as being unpatentable over Wiser in view of Kupka is incorporated herein. In addition, the user identification information is stored in the memory of the terminal unit is set by the user and includes a user name; (Kupka, pg. 28, lines 9-10) and the user identification information includes information unique to the terminal unit, having been set at the time of shipment from the factory. (compound key includes unique identifier)

16. As per claim 59, the rejection of claim 1 under 35 USC 103(a) as being unpatentable over Wiser in view of Kupka is incorporated herein. In addition, the method further comprising, prior to encrypting the data to be recorded, changing the

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user identification information sent to the recorder to content data owner identification information, wherein the data to be recorded is encrypted using the owner identification information. (Wiser, col. 19:25-31; Kupka, pg. 27, line 22-pg. 28, line 7: the compound key is generated for the purchase of online data by a user) It would be obvious to one of ordinary skill in the art at the time the invention was made for the media identification information to include user identification, wherein the user identification is utilized as part of the encryption key to secure the requested electronic data. One would be motivated to do so to provide additional security by associating the downloaded electronic data to the user, as taught by Kupka, pg. 27, lines 22-26. The aforementioned cover the limitations of claim 59.

17. Claims 7 and 25 are rejected under 35 USC 103(a) as being unpatentable over Wiser in view of Kupka, and further in view of Searle USPN 6,683,954 (hereinafter Searle).

18. As per claim 7, the rejection of claim 6 under 35 USC 103(a) as being unpatentable over Wiser and Kupka is incorporated herein. Neither Wiser nor Kupka discloses the user identification information including information unique to the terminal unit, having been set at the time of shipment from the factory. Searle discloses incorporating user specific information based on hardware information including a processor id, a network card address, a checksum of a component and the serial number of a hard disk drive, to generate an encryption key based on specific user

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information, which reduces fraud. (col. 2:13-28) Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made for the user identification information to include information unique to the terminal unit, having been set at the time of shipment from the factory. One would be motivated to do so to generate identification information specific to a user and the hardware used by the user. The aforementioned cover the limitations of claim 7.

19. As per claim 25, the rejection of claim 24 under 35 USC 103(a) as being unpatentable over Wiser and Kupka is incorporated herein. Neither Wiser nor Kupka discloses the user identification information including information unique to the terminal unit, having been set at the time of shipment from the factory. Searle discloses incorporating user specific information based on hardware information including a processor id, a network card address, a checksum of a component and the serial number of a hard disk drive, to generate an encryption key based on specific user information, which reduces fraud. (col. 2:13-28) Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made for the user identification information to include information unique to the terminal unit, having been set at the time of shipment from the factory. One would be motivated to do so to generate identification information specific to a user and the hardware used by the user. The aforementioned cover the limitations of claim 25.

Allowable Subject Matter

20. Claims 8-15, 26-33 and 36-58 are allowed.
21. Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Communications Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jung W. Kim whose telephone number is 571-272-3804. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JK

October 3, 2004



KAMBIZ ZAND
PRIMARY EXAMINER